



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,955	10/15/2003	Mitch Fredrick Singer	113748-4836US	8821
27189	7590	09/19/2008		
PROCOPIO, CORY, HARGREAVES & SAVITCH LLP			EXAMINER	
530 B STREET			MURDOUGH, JOSHUA A	
SUITE 2100				
SAN DIEGO, CA 92101			ART UNIT	PAPER NUMBER
			3621	
			NOTIFICATION DATE	DELIVERY MODE
			09/19/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@procopio.com
PTONotifications@procopio.com

Office Action Summary

Application No.

10/686,955

Applicant(s)

SINGER ET AL.

Examiner

JOSHUA MURDOUGH

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 39 is/are pending in the application.
- 4a) Of the above claim(s) 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CI/100)
Paper No(s)/Mail Date 6/30/2008, 8/5/2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. This action is responsive to Applicants response received on 30 June 2008 and the IDS submission received 5 August 2008.
2. Claims 1-20 and 39 are pending.
3. Claim 39 is withdrawn.
4. Claims 1-20 have been examined.

Claim Rejections - 35 USC § 112 2nd Paragraph

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-19 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. Claim 1 recites the limitation "said content" in line 5. There is insufficient antecedent basis for this limitation in the claim. It is unclear if Applicants are referring to the content being bound in line 1, or the discrete version of content from line 2, or if these are actually the same content being referred to by two different names. For purposes of prior art, the Examiner has adopted the first interpretation. The claim is required to "apprise[] one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent." See MPEP 2173.02. By not adapting a consistent naming convention, one of ordinary

skill in the art would not be provided this clear warning as to what constitutes infringement, if the claim were to be allowed.

8. Claim 1 recites the limitation “enabling a bound instance to bind said content to said hub network” in lines 6-7. A “bound instance” would be recognized by one of ordinary skill in the art to contain content, and thus, the content would already be bound to the hub network. Therefore it would not be understood what steps need to be performed to enable the binding of content to a network it is already bound to. For purposes of prior art, the Examiner has used the definition below for “enable” and the perspective that nothing needs to be done in order to maintain the binding to interpret this limitation as only requiring the creation of a bound instance.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-10 and 13-20 are rejected under 35 U.S.C. §102(e) as being anticipated by Chase JR (2003/0187801) hereafter “Chase”.

7. As to claim 1, Chase shows:

- a. A method of binding content to a hub network, comprising:
- b. receiving a request to bind a discrete version of content (Figure 1, element 12) to a hub network (Figure 1, element 10), including a server (Figure 1, element 22) and a

client (Figure 1, element 14) as members of said hub network (the user requests a license [0018] that binds the discrete content and the license to a "black box" [0017]. Therefore, the request is also a request to bind the content.),

c. wherein said discrete version includes discrete locked content data [0016], and wherein said content is stored on said server ("content server," Figure 1, element 22);

d. disabling said discrete version (encrypting it would make it disabled until the correct key is applied) and enabling a bound instance to bind said content to said hub network (the "black box" is part of the hub network, therefore, binding the instance to the "black box" effectively binds the content to the hub network [0017]);

e. creating a source version **12p** (the server 22 is the distribution source [0118], therefore the version on the server would be the source version) of said content stored on said server, wherein said source version includes source locked content data [0011] [0083]; and

f. creating a root license stored on said server (since the license is encrypted with the private root key, it is understood to be a root license [0213]),

g. wherein said root license is bound to said hub network (the private root key is unique to the server [0213], therefore the license cannot be read outside of the network).

8. As to claim 2, Chase further shows:

h. receiving said discrete version stored on compliant media [0080];

i. wherein compliant media is readable and writable electronic storage media [0080].

9. As to claim 3, chase further shows:

said discrete version has a corresponding discrete license (Figure 8, element 16).

10. As to claim 4, Chase further shows:

disabling said discrete version includes disabling said discrete license (Abstract).

11. As to claim 5, Chase further shows:

creating said root license includes creating said root license according to said discrete license [0214]-[0220].

12. As to claim 6, Chase further shows:

said server will decrypt said discrete locked content data after disabling said discrete version upon request [0016].

13. As to claim 7, Chase further shows:

said root license indicates said server has root responsibility for said source version (Through the root license, the root server delegates its authority to other servers [0221]).

14. As to claim 8, Chase further shows:

- j. creating a copy of said discrete locked content data [0080]; and
- k. storing said copy as said source locked content data [0080].

15. As to claim 9, Chase further shows:

- l. creating bound licensing authority data according to discrete licensing authority data [0221];
- m. wherein said discrete licensing authority data corresponds to said discrete version (Figure 1, element 12p) and said discrete licensing authority data indicates an external server is an external licensing authority (Figure 1, element 24), said bound licensing

authority data corresponds to said source version and said bound licensing authority data indicates said root license is a local licensing authority and said external server is an external licensing authority [0221].

16. As to claim 10, chase further shows:

said discrete version has a corresponding revocation list of one or more revoked devices wherein a revoked device is a device with an authorization to participate in a hub network has been revoked [0159].

17. As to claim 13 Chase further shows:

creating a revocation list corresponding to said source version by creating a copy of said revocation list corresponding to said discrete version (as the revocation list is part of the license, and the license terms are distributed with the content [0212] the list is contained in the source version).

18. As to claim 14, Chase further shows:

said server and said client are both compliant devices, a compliant device will not decrypt locked content data without a license that is bound to a hub network of which the compliant device is a member (This is inherently true, as the content is locked/encrypted by a key that binds it to the DRM system. [0017]-[0018]).

19. As to claim 15, Chase further shows:

a compliant device that is not a member of said hub network will only decrypt said discrete locked content data upon request while said discrete version is not disabled (the license can be disabled, thus a compliant device detecting a disabled

license would not be able to retrieve the content key, and thus not be able to decrypt the content [0020]).

20. As to claim 16, Chase further shows:

- n. creating a source key by copying a discrete key (same key for both, therefore it must have been copied [0212]);
- o. wherein said discrete key is for decrypting said discrete locked content data, and said source key is for decrypting said source locked content data [212].

21. As to claim 17, Chase further shows:

said discrete locked content data is encrypted using a content encryption technique, said source locked content data is encrypted using said content encryption technique, said discrete key is encrypted using a hub network encryption technique that is different from said content encryption technique, and said source key is encrypted using said hub network encryption technique [0011].

22. As to claim 18, Chase further shows:

said server stores a hub network key for decrypting data encrypted using said hub network encryption technique [0012]-[0013].

23. As to claim 19, Chase further shows:

said hub network encryption technique is different from said content encryption technique because said hub network encryption technique uses a different key for encrypting data than the key that said content encryption technique uses for encrypting data [0011].

24. As to claim 20, Chase further shows:

said root license is encrypted using said hub network encryption technique [0213].

Claim Rejections - 35 USC § 103

25. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

26. Claims 11 and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Chase.

27. As to claim 11, Chase further shows a check for the revocation of user's license [0306].

28. Chase does not show the check being performed prior to accepting content to the server.

However, the steps would be the same as those performed for the user. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Chase to include the check prior to allowing content to be uploaded in order to prevent the repeated uploading of content with viruses to the server.

29. As to claim 12, Chase further shows the updating of the revocation list [308] and a check for the revocation of user's license [0306].

30. Chase does not show these concepts in relation to the server. However, the steps would be the same as those performed for the user. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Chase to include the check prior to allowing content to be uploaded in order to prevent the repeated uploading of content with viruses to the server.

Definitions

31. To the extent that the Examiner's interpretations are in dispute with Applicants' interpretations, the Examiner hereby adopts the following definitions—under the broadest reasonable interpretation standard—in all his claim interpretations.¹ Moreover, while the following list is provided in accordance with *In re Morris* (127F.3d 1048, 44 USPQ2d 1023 (Fed. Cir 1997)), the definitions are a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

Enable: “1 a : to provide with the means or opportunity... b : to make possible, practical or easy” Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

Response to Arguments

32. Applicant's arguments filed 30 June 2008 have been fully considered but they are not persuasive.

33. Applicants argue:

“This rejection fails to take into account the definition of a source version clearly stated in the Specification. That is, once the discrete instance is disabled and the bound instance is enabled, the locked content data stored by the server is used as the source for copies of the

¹ While most definition(s) are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

content data in the hub network and is used as the "source version." In this regard, it cannot be argued that the server 22 of Chase is the source for the "source version", which includes "source locked content data." (Remarks, Page 11, last point)

34. Examiner's response:

Disregarding the potential argument to the clarity of the supposed definition, the Examiner contends that Chase does in fact show the distribution of locked content data as the "source version."

Preferably, the content server 22 in the architecture 10 has a unique public/private key pair (PU-CS, PR-CS) that is employed as part of the process of evaluating a license 16 and obtaining a decryption key (KD) for decrypting corresponding digital content 12, as will be explained in more detail below. [0083]

35. Applicants argue:

Regarding the rejection of claim 5, Section 15 of the Office Action states that the limitation of claim 5 is shown in Paragraphs [0214]-[0220] of Chase. According to other sections of the Office Action, the root license is disclosed as being equivalent to the private root key (PR-R) in [0213] of Chase and the discrete license is disclosed as being equivalent to element 16 in Figure 8 of Chase. However, Paragraphs [0214]-[0220] of Chase do not show that the private root key (PR-R) is created according to the license 16. Instead, Paragraph [0217] seems to indicate that the license 16 is created using "the certificate from the root entity (CERT (PU-LS) S (PR-R))." (Remarks, Page 12, paragraph 1)

36. Examiner's response:

The various keys are distributed according to the license provisions stored in the Content-Key Database (Figure 1, element 20). The discrete license 16, is used to create the provisions for distributing the different keys such as the decryption key (KD), which is used to decrypt each package 12p, which is a distributed copy of the discrete version that is to be bound to the hub network [0054].

37. Applicants argue:

"Regarding the rejection of claim 6, Section 16 of the Office Action states that the limitation of claim 6 is shown in Paragraph [0016] of Chase. However, Paragraph [0016] of Chase merely states the "user should not be able to decrypt and render the encrypted digital content without obtaining such a license from the license server. The obtained license is stored in a license store in the user's computing device." As mention above, after disabling the discrete version, the discrete locked content data needs to be decrypted in order to create the source version. See Paragraph [0032] of the publication. Therefore, Chase does not disclose that the server will decrypt the discrete locked content data after disabling the discrete version." (Remarks, Page 12, paragraph 2)

38. Examiner's response:

After review of Paragraph [0032] of the publication as referenced by Applicants, the Examiner finds that this argument is not supported by this passage. The passage shows, as

previously argued, that “once the discrete instance is disabled and the bound instance is enabled, the locked content data stored by the server is used as the source for copies of the content data in the hub network and is used as the ‘source version.’” Nowhere does this passage say that the “source version” requires that the content be decrypted. In fact it says exactly the opposite, as the “source version” contains locked content data, which as explained in Paragraph [0032], “The locked content data is locked by being protected from unauthorized access, such as by encryption.”

39. Applicants argue:

“Paragraph [0080] in conjunction with Figure 1 seems to indicate that it is the discrete version (i.e., element 12p) that is stored in the server. Paragraph [0080] of Chase does not disclose any element that may represent the source locked content data.” (Remarks, Page 13, partial paragraph)

40. Examiner’s response:

The digital content is referred to as being element 12 regardless of the form it is in. As can clearly be seen in Figure and Paragraphs [0051]-[0053], this content is copied into a package 12p which includes the content in an encrypted form so that it can be bound to the network via a black box 30. The reference’s indiscretion as to using 12 or 12p admittedly makes the reference harder to follow, however, the Examiner’s position is that one of ordinary skill in the art would have reasonably interpreted Chase in the manner cited to show the claimed limitations.

41. Applicants' other arguments are in regards to the amended claim language and therefore have been addressed in the art rejections.

Conclusion

42. This action is made final. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

43. A shortened statutory period for reply to this final action is set to expire three months from the mailing date of this action. In the event a first reply is filed within two months of the mailing date of this final action and the advisory action is not mailed until after the end of the three-month shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than six months from the mailing date of this final action.

44. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The Examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

45. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

46. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J. M.
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621